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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

DK-US035114

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Signature _____

Typed or printed name _____

Application Number

09/936,618

Filed

March 5, 2002

First Named Inventor

Norio MAEDA et al.

Art Unit

3749

Examiner

Jiping Lu

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 56,232

David J. McCrosky
Signature

David J. McCrosky

Typed or printed name

(202)-293-0444

Telephone number

November 16, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

DK-US035114

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	
	:	
Norio MAEDA et al.	:	
	:	Patent Art Unit: 3749
Serial No.: 9/936,618	:	
	:	Examiner: Jiping Lu
Filed: March 5, 2002	:	
	:	
For: METHOD AND DEVICE FOR DRYING	:	
SUBSTRATE	:	

REQUEST FOR PRE-APPEAL CONFERENCE

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

In accordance with the Notice published in the July 12, 2005 Official Gazette, Applicant hereby requests a Pre-Appeal Conference. A Notice of Appeal and the appropriate fees are filed with this request. No fee is believed to be due for the proper submission of the request. However, the Commissioner is authorized to charge any fees necessary associated with an extension of time to Deposit Account No. 50-1836.

Background

Claims 1-3, 5-12, 14-20, 22-24 and 26-28 were finally rejected in the May 17, 2006 Final Office Action.

Claim 20 was rejected under 35 U.S.C. 112, first paragraph. An After Final Amendment was filed on October 31, 2006 cancelling claim 20. Applicants believe the After Final Amendment was entered since it simplifies the issues for appeal. Thus, claim 20 will not be discussed herein. Claims 1-3, 5-12, 14-19, 21-24 and 26-28 are pending with claims 1, 10, 21, 23 and 28 being the independent claims. Claim 21 was indicated as allowed.

Concise Explanation of Arguments

The rejection of the claims is improper since individual elements in the reference are used to designate more than one claimed element.

In paragraphs 4 and 5 of the Office Action, claims 1, 3, 5, 7-12, 14, 17, 22-24 and 28 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,653,045 (Ferrell) or U.S. Patent No. 5,772,784 (Mohindra et al).

It is well established in U.S. patent law that two separate elements in the claims **cannot** be designated as the same element in the references.

In paragraph 4 of the Office Action, the valves 612, 614, the drain 620 and the level 622 of Ferrell are designated as making up two separate claimed elements. The valves 612, 614 are designated as constituting the means for supplying inert gas **and** then designated again as constituting a means for maintaining a predetermined thickness of the drying fluid. In the same fashion, the drain 620 is designated as constituting a means for maintaining a predetermined thickness of the drying fluid **and** designated as a means for continuously lowering a fluid face. Moreover, the level 622 is designated as a fluid face **and** designated as a means for maintaining a predetermined thickness of the drying fluid.

Accordingly, Applicants respectfully assert that the rejection of the claims using Ferrell is improper since individual elements of Ferrell are used to designate more than one claimed element.

Likewise, in paragraph 5 of the Office Action, the drain region 231, the drain valve 236 and the substrate carrier support 248 of Mohindra et al are designated as making up two separate claimed elements. The drain region 231 and the drain valve 236 are designated as constituting the step of lowering a fluid face (claim 1), means for lowering a fluid face (claim 10) and an exhausting section (claims 23 and 28) **and** then designated as constituting a step, means or device for maintaining a predetermined thickness of the drying fluid. In the same fashion, the substrate carrier support 248 is designated as constituting a supporting means **and** then designated as constituting a means for maintaining a predetermined thickness of the drying fluid.

Accordingly, Applicants respectfully assert that the rejection of the claims using Mohindra et al is improper since individual elements of Mohindra et al are used to designate more than one claimed element.

The predetermined thickness is greater than zero. Precedent should be followed in determining the meaning of terms in the claims.

Throughout the Office Action, the claimed predetermined thickness is considered as zero. The Office Action has applied an **arbitrary** definition to the word “thickness” such that the thickness of the drying fluid is zero and as such does not exist.

Applicants respectfully submit that the term “thickness” should be given its meaning within the scope of the specification. The Federal Circuit in *Phillips v. AWH Corp.*, 415 F.3d

1303 (Fed. Cir. 2005) stated that a definition cannot be arbitrarily chosen in interpreting the claims. The Federal Circuit found that arbitrarily chosen definitions focus on the abstract meaning of words rather than on the meaning of the claim term to the artisan within the context of the specification. Thus, according to *Phillips*, the meaning of “thickness” should be determined from the context of the specification and the claims.

The thickness of the drying fluid is discussed at, for example, paragraph [0039] on page 5 of the substitute specification. The thickness of the drying fluid is also discussed at, for example, paragraph [0046] on page 7 of the substitute specification. The text of paragraphs [0039] and [0046] are cited on page 11 of Applicants October 31, 2006 Response.

Applicants’ specification does not give an alternative meaning to “thickness” that implies a thickness of zero such that the drying fluid does not exist. For example, in the above paragraphs, a thickness of the drying fluid is used in order to achieve few drying marks using the Marangoni effect. Thus, Applicants use the term “thickness” in the specification and claims in relation to a drying fluid that is actually in three dimensional existence. In view of *Phillips* and Applicants’ specification, the drying fluid should be considered as actually having a thickness and existing rather than arbitrarily assigning a thickness of zero and regarding the drying fluid as not in three dimensional existence.

The claims themselves also define a liquid layer of a drying fluid with a thickness greater than zero, i.e., a drying fluid that exists. For example, in independent claims 1, 10, 21, 23 and 28, “the drying fluid” is repeatedly recited within the claims. Furthermore, “a liquid layer of a drying fluid” is not stated in the alternative. Thus, the claims require a drying fluid to exist within the claimed method or device. In order for the drying fluid to exist, there must be a thickness greater than zero.

Not only do the claims repeatedly call for a drying fluid, but the claims further state a **thickness** of a liquid layer of the drying fluid. By specifically requiring a drying fluid **and** a thickness of a liquid layer of the drying fluid, the claims require a three dimensional existence. The claims twice require a drying fluid to exist with a thickness, the thickness being greater than zero.

Accordingly, since the claims require that a liquid layer of the drying fluid actually exist, the prior art of record does not disclose a method step of supplying liquid drops onto a fluid face of a cleaning fluid such that a thickness of a liquid layer of the drying fluid on the cleaning fluid is continuously maintained to be equal to or greater than a predetermined

thickness. In addition, the prior art of record does not disclose a means for controlling or a control device configured for controlling the supply of the inert gas and for maintaining a predetermined thickness of the drying fluid on the cleaning fluid.

Dependent Claims

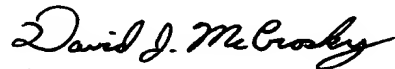
Applicants believe that dependent claims 2, 3, 5-9, 11, 12, 14-19, 22, 24, 26 and 27 are allowable over the prior art of record in that they depend from independent claims 1, 10 and 23, and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations.

The further allowability of a selection of the dependent claims is discussed at pages 13-18 of the October 31, 2006 Response.

Conclusion

In view of the above comments, Applicant respectfully requests that the rejections be withdrawn. Applicants respectfully assert that claims 1-3, 5-12, 14-19, 21-24 and 26-28 are in condition for allowance.

Respectfully submitted,



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